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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/784,719

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Matthew B. Schoen

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EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT

PAPER NUMBER

3692

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/784,719	<b>Applicant(s)</b> SCHOEN ET AL.	
	<b>Examiner</b> Susanna M. Diaz	<b>Art Unit</b> 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-171 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-171 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This restriction requirement is set forth in response to Applicant's response filed January 14, 2009. In Applicant's response, Applicant amended the claims to clarify that a monetary obligation is a financial liability, thereby incorporating subject matter from the original claims. However, as explained in the Notice of Non-Responsive Amendment mailed September 19, 2008, while the issue of election by original presentation may have been obviated by Applicant's current claim amendments, the dependent claims present various sets of species.

Claims 1-171 are pending.

### ***Election/Restrictions***

2. This application contains claims directed to the following patentably distinct species (one species from *each* group may be elected for examination):

**Group A** – The type of financial liability is established. Please select one of the following species. Also, any species that are obvious variants of one another may be asserted as such and a request may be made that these respective species be examined together. For example, species A-1 may be examined with another elected species that is asserted to be a type of financial product. Species A-2 may be examined with another elected species that is asserted to be a type of financial guarantee.

***Species A-1:*** Directed toward a financial liability that is associated with a financial product. (Claims 5, 85)

**Species A-2:** Directed toward a financial liability that is associated with a financial guarantee. (Claims 6, 86)

**Species A-3:** Directed toward a financial liability that is associated with a hedge. (Claims 7, 87)

**Species A-4:** Directed toward a financial liability that is associated with a forward contract. (Claims 8, 9, 27, 30, 31, 88, 89, 107, 110, 111)

**Species A-5:** Directed toward a financial liability that is associated with a swap. (Claims 8, 10, 28, 30, 32, 88, 90, 108, 110, 112)

**Species A-6:** Directed toward a financial liability that is associated with an option. (Claims 8, 11, 29, 30, 33, 88, 91, 109, 110, 113)

**Species A-7:** Directed toward a financial liability that is associated with a swaption. (Claims 8, 12, 30, 34, 88, 92, 110, 114)

**Species A-8:** Directed toward a financial liability that is associated with a bond. (Claims 13, 93)

**Species A-9:** Directed toward a financial liability that is associated with a cash value of an insurance policy. (Claims 14, 94)

**Species A-10:** Directed toward a financial liability that is associated with a reserve of an insurance policy. (Claims 15, 95)

**Species A-11:** Directed toward a financial liability that is associated with a stable value wrap. (Claims 16, 96)

**Species A-12:** Directed toward a financial liability that is associated with a redemption value wrap. (Claims 17, 97)

**Species A-13:** Directed toward a financial liability that is associated with a rate of return guarantee. (Claims 18, 98)

**Species A-14:** Directed toward a financial liability that is associated with a disability payment stream. (Claims 19, 99)

**Species A-15:** Directed toward a financial liability that is associated with a long-term care policy. (Claims 20, 100)

**Species A-16:** Directed toward a financial liability that is associated with an annuity payment stream. (Claims 21, 101)

**Species A-17:** Directed toward a financial liability that is associated with a health care expense. (Claims 22, 102)

**Species A-18:** Directed toward a financial liability that is associated with an income loss. (Claims 23, 103)

**Species A-19:** Directed toward a financial liability that is associated with a property loss. (Claims 24, 104)

**Species A-20:** Directed toward a financial liability that is associated with a liability expense. (Claims 25, 105)

**Species A-21:** Directed toward a financial liability that is associated with an injury loss. (Claims 26, 106)

**Species A-22:** Directed toward a financial liability that is associated with a forward contract. (Claims 170, 171)

**Group B** – The type of diversification requirement is established. Please select one of the following species.

***Species B-1:*** Directed toward a diversification requirement that comprises a requirement of a reduction in diversifiable risk. (Claims 43, 123)

***Species B-2:*** Directed toward a diversification requirement that comprises a requirement that the members of the pool represent at least two industries. (Claims 44, 124)

***Species B-3:*** Directed toward a diversification requirement that comprises a requirement of a geographic dispersion of risks taken. (Claims 45, 125)

***Species B-4:*** Directed toward a diversification requirement that comprises a requirement of a type of risk taken by at least one of the members of the pool. (Claims 46, 126)

***Species B-5:*** Directed toward a diversification requirement that comprises a category requirement of collateral provided by the members of the pool. (Claims 47, 127)

**Group C** – A term of a diversification formula is established. Please select one of the following species.

***Species C-1:*** Directed toward a diversification formula that includes a covariance for earnings term. (Claims 49, 129)

***Species C-2:*** Directed toward a diversification formula that includes a losses term. (Claims 50, 130)

**Species C-3:** Directed toward a diversification formula that includes a covariance of returns term. (Claims 51, 131)

**Group D** – A type of goal is established. Please select one of the following species.

**Species D-1:** Directed toward establishing a goal regarding value creation. (Claims 52, 132)

**Species D-2:** Directed toward establishing a goal regarding returns earned. (Claims 53, 133)

**Species D-3:** Directed toward establishing a goal regarding expenses incurred. (Claims 54, 134)

**Species D-4:** Directed toward establishing a goal regarding default risk. (Claims 55, 135)

**Species D-5:** Directed toward establishing a goal regarding income earned. (Claims 56, 136)

**Group E** – A trigger for monitoring is established. Please select one of the following species.

**Species E-1:** Directed toward the monitoring being responsive to input reports from each pool member. (Claims 65, 145)

**Species E-2:** Directed toward the monitoring being responsive to input from credit rating agency reports. (Claims 66, 146)

**Species E-3:** Directed toward the monitoring being responsive to input from asset valuation service reports. (Claims 67, 147)

**Species E-4:** Directed toward the monitoring being responsive to input from auditor reports. (Claims 68, 148)

**Species E-5:** Directed toward the monitoring being responsive to input from regular reports. (Claims 69, 149)

**Group F** – A trigger event for determining is established. Please select one of the following species.

**Species F-1:** Directed toward the determining being responsive to an event comprising a change in a credit rating. (Claims 162, 166)

**Species F-2:** Directed toward the determining being responsive to an event comprising a change in amount of the financial liability. (Claims 163, 167)

**Species F-3:** Directed toward the determining being responsive to an event comprising a change in collateral. (Claims 164, 168)

**Species F-4:** Directed toward the determining being responsive to an event comprising a change in diversification. (Claims 165, 169)

3. The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.



Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-4, 35-42, 48, 57-64, 70-84, 115-122, 128, 137-144, and 150-161 are generic.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined** even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are

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added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 8 am - 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susanna M. Diaz/  
Primary Examiner, Art Unit 3692